

## **REMARKS**

The Examiner is thanked for the examination of the application. In view of the foregoing amendments and the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections. The Examiner is also thanked for the courtesy of the interview granted Applicants' attorney on August 3, 2010. The substance of the interview is incorporated in the following remarks.

### **Comments on Advisory Action:**

In the Advisory Action, the Examiner alleges that the "circuit" language added to claim 17 was too broad. Accordingly, claim 17 is further amended to recite "electronic circuit". Such language should overcome the objections set forth in the Advisory Action.

With regard to the 35 USC 112, second paragraph, rejection, the Examiner argues that the comments at the top of page 18 in the previous response were open ended and do not limit the scope of the claims. The open ended language has been clarified. Accordingly, the remarks set forth below clearly establish that the claims are in compliance with 35 USC 112.

### **35 USC § 112, second paragraph:**

Claims 1, 3 - 9, 11 - 15, 17 - 34, and 42 - 47 have been rejected under 35 USC § 112, second paragraph. The Office Action alleges that the specification discloses multiple steps that could be covered by certain elements of the claims. Specifically, the Office Action alleges that it is not clear which portions of the

specification relate to the “means for detecting a user selection” in claim 1. The Office Action refers to step S101, step S102, the step before S101, and step S103.

The complete language of the “means” step includes “means for detecting a user selection of a plurality of document blocks that is marked by the user by scanning a document on which the user has marked the plurality of document blocks”.

At the interview, the Examiner expressed concern that the claim language may be so broad that it covers more than one of the steps mentioned above *in the alternative*, i.e., that it might cover **only one** of step S101, step S102, the step before S101, and step S103. In particular, the Examiner was concerned that the claim language may cover **only one** of the four steps, and that the meaning of the claim would thus not be clear. Applicants submit that the claim language covers only step S101, and that there is no ambiguity. However, the claim is not limited to the specific disclosed embodiment.

According to the specification, step S101 includes executing a pre-scan and the pre-scan image data are input to the mark detecting section 171. See paragraph [0057] of the published application, U.S. 2002/0028020. The mark detecting section 171 detects the line 12. See Figure 4 and paragraph [0058]. Although the claims are not limited to the preferred disclosed embodiments, the Examiner is advised that the line 12 relates to the user selection, and the “means for detecting a user selection” of claim 1 relates to the scanning process in which the line 12 is detected.

Step S102 is a step that is conducted after step S101. Step S102 is for determining whether or not the mark, e.g., line 12, has been detected. **Step S102**

***does not relate to detecting the mark itself.*** It is a step that is conducted ***after*** the mark detecting step.

Step S103 is a process that is executed ***if*** it is determined that the mark was not detected in step S102. Thus, step S103 also does not relate to detecting the mark.

The step before step S101 refers to the user placing a mark on the document, such step is not included in “means for detecting a user selection”. The detection of a user selection presumes that the user selection has already been made.

Thus, it should be clear that the “means for detecting a user selection” can only relate to step S101 – at least in the disclosed embodiment. However, as set forth above, the claims are not limited to the preferred disclosed embodiments.

However, claim 1 is an open claim. It is clear that an open claim may cover a device that includes elements in addition to those recited in the claim. Thus, there is no language in claim 1 that precludes the claim from covering a device that, in addition to having “means for detecting a user selection”, can also have means for conducting step S102, the step before S101, or step S103. Thus, the claimed device may be capable of conducting step S102, the step before S101, or step S103. However, it is not required that the claimed device be capable of conducting step S102, the step before S101, or step S103.

The Examiner was concerned about language in the cited USPTO *Love* memos that identified situations of potential ambiguity when claim language may read on different steps in the alternative, i.e., when claim language may read on disclosed step A or disclosed step B. However, that is not the case in the present application, since the claim language reads on only one step.

Similar analysis applies to the remaining independent claims. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection.

If the Examiner is of the opinion that additional issues remain concerning 35 USC 112, the Examiner is encouraged to telephone the undersigned so that proper resolution can be promptly reached.

**35 USC 101:**

Claims 17, 24 – 26, 30, and 44 have been rejected as allegedly directed to nonstatutory subject matter. At the interview, the Examiner recommended that two elements in claim 17 be amended to clarify that such steps were conducted by a circuit. Claim 17 has been amended as suggested, thus avoiding any possible issue under 35 USC 101.

Applicants also submit that the "reconstructing" step of claim 17 is a transformation, as contemplated by the *Bilski* machine or transformation test.

Accordingly, Applicants submit that the claims are all directed to statutory subject matter.

**Prior Art issues:**

Although there are no pending prior art rejections, the Examiner and Applicants' attorney discussed two prior art references: U.S. Patent No. 6,466,954, hereinafter "*Kurosawa*", and U.S. Patent No. 5,201,011, hereinafter "*Bloomberg*". The Examiner alleged that *Kurosawa* may teach steps similar to step S102, and that *Bloomberg* may teach step S101.

*Kurosawa* discloses that "in a document image processing apparatus to input a document as the image data (for example, a facsimile apparatus or a copy machine), a user indicates the necessary area to be edited from the document on a display using a pointing device." See column 1, lines 14 - 18. Thus, *Kurosawa* requires a **display** for the user to select the plurality of document blocks. Further, since the display of *Kurosawa* would need to reproduce the contents of the documents in a form recognizable to the user selecting portion(s) thereof, *Kurosawa* requires a relatively large (and expensive) display. The present claims, however, do not require a display for the user to select the plurality of document blocks. In particular, as explained on page 9, lines 19 - 21, of the present specification, the "mark is added to the document by the user beforehand using a marker such as a felt-tip pen or the like." The marked document is then scanned.

*Bloomberg* is older technology that simply teaches how a scanner can detect a hand marking. *Bloomberg* does not overcome the deficiency of *Kurosawa*.

### **Conclusion:**

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge  
our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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